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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,149	12/23/2005	Matthias Vennemann	VOSS-0030	5535

7590 02/17/2010
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EXAMINER

DESAI, RITA J

ART UNIT	PAPER NUMBER
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1625

MAIL DATE	DELIVERY MODE
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02/17/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/562,149	Applicant(s) VENNEMANN ET AL.	
	Examiner Rita J. Desai	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) -18,21-26- is/are pending in the application.
- 4a) Of the above claim(s) 22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-18, 21, 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim 1 has been cancelled and applicants have added claim 25 and 26 as independent claims.

Claims 22-23 are withdrawn as

Claims pending are claims 2-18, 21, 24-26 are pending.

The claims have been amended to a certain extent but they are not amended to the elected group.

The restriction made in the paper 2/9/09 reads as follows

Group I, claim(s) 1-18 and 21, drawn to compounds and pharmaceutical compositions of formula I wherein R2 and R3 do not form a ring, none of the R's form a ring (i.e. it is a tricyclic ring) and R7 is a phenyl or naphthyl (substituted or unsubstituted).

Group II, claim(s) 1-18 and 21, drawn to compounds and pharmaceutical compositions of formula I wherein R2 and R3 do not form a ring, none of the R's form a ring (i.e. it is a tricyclic ring) and R7 is a pyridyl or a quinoline.

Group III, claim(s) 1-18 and 21, drawn to compounds and compositions of formula I, wherein R2 and R3 do not form a ring, none of the R's form a ring (i.e. it is a tricyclic ring) and R7 is a group other than in group I and II.

In the response filed 2/27/09 applicants elected group I

In response to the Office Action mailed on February 9, 2009, applicants elect with traverse Group I, claims 1-18 and 21, drawn to compounds and pharmaceutical compositions of formula I wherein R2 and R3 do not form a ring, none of the R's form a ring (i.e. it is a tricyclic ring) and R7 is a phenyl or naphthyl (substituted or unsubstituted).

The claims recite R7 to includes Het 2 which is a quinolyl part of group II.

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Regarding the 103 rejection applicants argue that they have amended the claims to have R41 to be an alkyl.

There is no data given that this alkyl at that position has any unexpected results. The genus in the prior art is not very large. The R5 is phenyl and the options for the substituents are only 5. So the arguments that the differences are numerous is not convincing. The are compounds disclosed by the reference The activity is the same and the compounds have a very close similarity. Also there is no showing of unexpected results.

So the rejection still stands.

The rejection of the claims under ODP over 10/562137 also still stand. Applicants argue that the assignee is not the same, that may be but the it does have 3 common inventors.

The difference is only in the position of R5 and R41 methyl groups making them positional isomers. The R7 is the same which is phenyl as elected in both.

The rejection under ODP over 11/794497 also still stands as the claims have not been patented or abandoned as yet in the later case. The claims at this time are not in a condition for allowance at time for the ODP rejection to be withdrawn.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rita J. Desai/
Primary Examiner, Art Unit 1625

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February 2, 2010.